

REMARKS

1. In the Office Action, the Examiner rejected all pending claims (Claims 175-197) under 35 U.S.C. 103(a) as being unpatentable over Perry (U.S. Pat. No. 5,241,466) in view of Krim (U.S. Appl'n Pub. No. 2002/0072925). For the reasons discussed below, the Applicant respectfully submits that a prima facie conclusion of obviousness has not been established based upon Perry in view of Krim.

The Prior Art References Must Be Considered in their Entirety

2. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Therefore, before moving into the specific bases for the Examiner's rejections and the Applicant's response, it will be helpful to review briefly the two references, as a whole, on which the Office Action is based.

3. The Perry Reference. Perry discloses a computer-based "central repository" for scanning in and storing "important documents," such as living wills and durable powers of attorney. Perry, at Col. 3, lines 19-24 (hereinafter cited as 3:19-24). The documents stored in the system have been previously written by or on behalf of the "customer." *Id.* at 4:57-62 (stating that the customer sends to the repository an application form with basic biographical data "as well as the necessary documents, such as a living will, durable power of attorney, testamentary will and authorization for donation of organs and bone marrow."). Upon receipt of the application and associated

documents, an operator of the system then enters the necessary information into the system to set up the customer's account or file. Id. at 5:1-11. Documents sent in with the application are "scanned" into the system and saved on optical storage for later retrieval. Id. at 5:35-36 ("Donor authorization forms, if necessary, are scanned at block 222 [of Fig.2, labeled 'SCAN DOCUMENTS'] and stored in optical storage 60"); Id. at 5:60-61 ("The living will documents are stored, at block 230 [labeled "SCAN DOCUMENTS"], into optical storage 60"); Id. at 6:15-16, 32-33 (similarly discussing the "scanning" of testamentary wills, codicils, or durable powers of attorney). When an authorized request is received by the system, the system accesses the stored, scanned-in copy of the previously existing document and sends it to the requestor. Id. at 8:58-66. The system also can retrieve information such as insurance information stored in the customer file. Id.

4. Thus, the customer of the system disclosed in Perry does not interact with the Perry system at all. The customer merely sends in an application form with basic biographical data along with pre-existing legal documents that are scanned in and stored as duplicates for later retrieval. The system of Perry does not provide the customer any guidance as to health-care or other end-of-life issues the customer might face; the system of Perry does not allow the customer to make choices pertaining to these issues via the system; and the system of Perry does not generate any new enforceable document in response to a request for information. As discussed throughout the entirety of the patent, Perry merely discloses a depository for scanning in pre-existing legal documents, which utilizes a computer system to index the documents for storage and retrieval.

5. The Krim Reference. Krim is a "delayed communication system" that

provides a "member" the ability to send a predetermined textual message to a predetermined list of recipients upon the occurrence of some condition, such as death. Krim, ¶ 9. After setting up his own account, the member designates the list of recipients he wants to receive the message. Krim, ¶ 20. The member then accesses the "Message Composition screen" and types in the content of the message that each recipient or group of recipients is to receive. Krim, ¶ 25. The message may include a living will or similar document, Krim, ¶ 27, but as disclosed, the customer creates the content of the message that is stored and pre-designates the person(s) to whom it is to be sent upon the occurrence of some event. Id. ¶ 36. A "custodian" is responsible for notifying the Krim system of the occurrence of the event. Id. ¶¶ 26, 50. In alternative embodiments, the member programs the system to send the messages on a date certain, or the system reviews records of deaths in publicly accessible databases for the death of the member. Id. ¶ 5, 47. Upon notification by the custodian, or on the date certain, or upon finding the death of a member in a public database, the Krim system simply sends the member's predetermined message to the designated list of recipients. Id. ¶ 5. The Krim system does not allow for a previously unknown information requestor that has not been designated by the member as a "designated recipient," such as a hospital or other health care provider, to request and receive information.

6. As with Perry, Krim relies entirely on the "member" for the content of the information later to be sent to a recipient. Krim does not provide the customer any guidance information responsive to input by the customer as to health-care or other end-of-life issues the customer might face; the system of Krim does not allow the customer to make choices pertaining to these issues via the system; and the system of Krim does not

respond to a request for information from some third party, such as a health care provider. The Krim system simply emails content predetermined by the member to a predetermined list of designated recipients on the occurrence of an event. As discussed in the entirety of the patent, Krim is merely a delayed email notification system.

It is the Examiner's Burden to Prove a Prima Facie Case of Obviousness

7. "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." MPEP § 2142. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure" Id.

The Examiner Has Not Identified Any Suggestion or Motivation to Combine Krim and Perry

8. The first step of the inquiry is that there must be some suggestion or motivation to combine the references. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01. "The mere fact that references can be

combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Id. (emphasis in original) (citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

9. The Examiner stated in the Office Action that “It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Krim within the system of Perry with the motivation of providing a communication which may be designated by the person to be transmitted on incapacity or imminent death, to a recipient designated by the person.” Office Action, ¶ 4 (pp. 3-4). As shown in paragraphs 15-16 below, this statement in and of itself would change the principle of operation of Perry and render it inoperable for its intended purpose and thus as a matter of law the references cannot be combined. However, before considering that point, it must be noted that the Examiner has not identified any suggestion or motivation to combine the references, as the MPEP and case law requires be done in order to establish a prima facie case of obviousness.

10. The conclusory statement in the Office Action that it “would have been obvious to one of ordinary skill in the art. . .” (quoted above) is inadequate as a matter of law to establish a suggestion or motivation to combine the references. The MPEP provides, “A statement that modifications of the prior art to meet the claimed invention would have been ” ‘well within the ordinary skill of the art at the time the claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.” MPEP § 2143.01 (emphasis in original) (citing Ex parte Levengood, 28

USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

11. Thus, before proceeding any further, a prima facie case of obviousness has not been established under the requirements of the MPEP and the obviousness rejection should be withdrawn.

As a Matter of Law, Krim Cannot Be Combined with Perry Because It Would Change their Principles of Operation of Krim and Render Each Unsuitable for its Intended Purpose

12. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01. Further, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." Id. (citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

13. The express purpose of Perry is to provide a "central repository" for scanning in and storing "important documents." Perry at 3:19-24. The documents are stored in the "repository" pending an information request from some entity or person. Id. at 8:37-44. Upon receipt of the information request, the system runs authorization procedures to determine if the requestor is authorized to receive the requested documents. Id. at 45-57. As described in the numerous examples provided in the patent, the requestor may be a person at a medical facility who calls an "800" number to determine if

the patient is a customer of the Perry system, and which then relays "pertinent information as to the customer, such as name, social security number, date of birth and the like" in order to request a particular type of document, such as a living will, organ donation form, and the like. *Id.* at 9:43-54. The Perry system then runs an authorization procedure. Clearly, given that the medical facility must provide "pertinent customer information," the medical facility is not a predetermined "designated recipient," as in Krim. At the time the "customer" of Perry elects to have his "important documents" scanned and stored in the "central repository," he of course does not know the identity of the medical facility in which he might in the future become incapacitated or die. To require an unknown future information requestor (such as a medical facility) in the system of Perry to be placed on a predetermined "recipient list," as required by Krim, would defeat the purpose of Perry—namely, to provide a "central repository" of important documents to be relayed in response to a specific information request to any medical facility or the like that might require the specific document at some unknown point in the future.

14. Krim, on the other hand, is "delayed communication system" that provides a "member" the ability to send a predetermined textual message to a predetermined list of recipients upon the occurrence of some condition or date certain or notification of death, in the future. Krim, ¶ 9. The system of Krim has no ability to respond to a specific information request for a particular type of document from some entity that is not a predetermined "designated recipient." Krim is a delayed one-way communication system to a predetermined list of designated recipients.

15. Thus, the principles of operation of Perry and Krim are entirely different.

Perry responds to external requests for information by sending specific documents responsive to the request. Krim sends out predetermined content via email to particular persons ("designated recipients") at a time or event predetermined by the "member." It would defeat the purpose of Perry to impose the requirement of Krim that information be distributed only to "designated recipients." Further, it would change the principle of operation of the "central repository" Perry—to send out previously scanned-in documents in response to specific requests for such documents—to impose Krim's one-way operation of a "delayed communication system."

16. Perry and Krim operate on different principles because each serves a different purpose. To combine the two in any way would require a change in the principle of operation and would make the changed reference unsuitable for its intended purpose. In the Office Action, the Examiner concluded, "It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Krim within the system of Perry with the motivation of providing a communication which may be designated by the person to be transmitted on incapacity or imminent death, to a recipient designated by the person." Office Action, ¶ 4 (pp. 3-4). As shown, that statement changes the principle of operation and purpose of Perry and is thus demonstrates the combination is an improper basis for an obviousness rejection. Therefore, according to the MPEP, it is improper to combine Perry and Krim and a prima facie case of obviousness cannot be established by modifying or combining these two references. The Applicant therefore requests the Examiner to withdraw his obviousness rejection based on the combination of these two references.

Neither Perry nor Krim, nor the Combination of the Two, Teach or Suggest All Claim Limitations of the Present Invention

17. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP § 2143.03.

18. Even if Krim and Perry are combined and modified in contradiction to the MPEP as cited above, their combination does not each or suggest each and every limitation of the two independent claims, Claims 175 and 187, as required to support a prima facie case of obviousness.

19. In the Office Action, the Examiner relies principally on Perry. Office Action, ¶ 4. Each stated basis for rejection of Claim 175 is addressed below.

a. The Examiner states "Perry discloses a method of providing a plurality of participants with the ability to effect choices about the future care of said participants . . ." Id., ¶ 4(a).

i. Perry nowhere discloses that its system allows its "customers" to "effect choices" about their future care. "Effect" is an active verb, and is synonymous in this context with "to make" or "to cause." The Perry system merely scans in pre-existing documents containing choices already made and memorialized by the "customer" in the document. The Perry system provides no interface or other method for a "customer" to make or cause or

effect a choice about future care via the Perry system.

- ii. This basic element in the preamble is therefore not met by Perry and the obviousness rejection should be removed.
- b. The Examiner states that Perry discloses the step "comprising receiving via an interactive interface from an input user end-of-life information relevant to the future care of a participant should said participant prior to death become incapacitated." Action, ¶ 4A (relying upon Perry at 5:38-68 to 6:33).
 - i. The cited passages of Perry do not disclose any sort of interactive interface at all. What is described in the cited passage of Perry is the logic of the system, not an interactive interface.
 - ii. This element in the claim is therefore not met by Perry and the obviousness rejection should be removed.
- c. The Examiner states that Perry discloses the step of "providing via said interface guidance information corresponding at least in part to said received information." Office Action, ¶ 4A (relying upon Perry at 5:38-68).
 - i. The cited passage of Perry does not disclose or suggest, and in fact says nothing at all about, "guidance information corresponding at least in part to said received information." As described in the claim of the instant Application, the guidance information provided via the interface to the input user corresponds at least partly to the information received from the user, i.e., is interactive.

Nowhere in Perry is it suggested that guidance information is provided to the user. As noted, Perry does not even disclose an interactive interface; therefore, it is impossible for Perry to provide via an interactive interface that it does not have guidance information corresponding to the information received from the input user.

- ii. This element in the claim is therefore not met by Perry and the obviousness rejection should be removed.
- d. The Examiner states that Perry discloses the step of "enabling said input user via said interface to select choices regarding said care, said end-of-life information comprising said selected choices." Office Action, ¶ 4A (relying upon Perry at 3:19-36).
 - i. The passage relied upon and cited by the Examiner discloses that Perry is merely a repository for scanning in and storing pre-existing documents memorializing choices previously made by the customer. The passage does not disclose or suggest anything about "enabling the user via said interface to select choices." Whatever choices the customer of Perry has made about his future care have been memorialized in the pre-existing documents, not by interacting with the interface of the system to make such choices. The system of Perry does not enable the customer to "select choices" via the Perry system; the system of Perry simply stores documents. Further, the "end-of-life information" cited in the

claim of the instant application corresponds to the choices made by the user using the interface. Because Perry does not enable the user to make choices, it does not disclose this aspect of the claim element either.

- ii. This element in the claim is therefore not met by Perry and the obviousness rejection should be removed.
- e. The Examiner states that Perry discloses the step of "storing in a computer-readable registry said end-of-life information in the form of an information set corresponding to said participant." Office Action, ¶ 4A (relying upon Perry at 3:19-36).
 - i. As noted immediately above, the "end-of-life information" cited in the claim of the instant application corresponds to the choices made by the user using the interface. Because Perry does not enable the user to make choices, it does not and cannot disclose this aspect of the claim element either.
 - ii. This element in the claim is therefore not met by Perry and the obviousness rejection should be removed.
- f. Turning to Krim, the Examiner states that Krim suggests "upon receipt of a verified request from a user aware of the occurrence of said incapacitated state in said participant, producing an information product derivative of said information set comprising in an enforceable form said participant's desired response to said incapacitating condition." Office Action, ¶ 4A (citing Krim, ¶¶ 5, 27-32).

- i. "All words of a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03. The cited passage of Krim does not disclose any sort of "verified request." As described in previous sections of this response, the system of Krim does not respond to information requests; instead, it simply sends out emails on notification of the occurrence of a predetermined event. There is no "request" involved in Krim. The cited element in the claim employs a different principle of operation than Krim.
- ii. The cited passages of Krim do not disclose "producing an information product derivative of said information set." Krim merely sends out the exact content that the "member" has entered into the system to designated recipients. Krim does not disclose or suggest in any way producing any information product derivative of any information set previously stored. Further, the antecedent of the "information set" in this element of the claim is the end-of-life information comprising the choices made by the user via the system's interactive interface. Krim does not disclose this aspect of the claim either.
- iii. The cited passages of Krim do not disclose the Krim system "producing . . . in an enforceable form said participant's desired response to said incapacitating condition." The Krim system does not function to "produce" any information product. It merely

emails to the designated recipient a copy of whatever document or content the member previously entered into the system.

- iv. These elements in the claim are therefore not met by Perry and the obviousness rejection should be removed.

20. Because each and every claim limitation of independent Claim 175 is not taught or suggested by the prior art, as required, the obviousness rejection of Claim 175 should be removed. Further, because independent claim 175 is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03. Therefore, the obviousness rejection should be removed as to Claims 176-186.

21. Regarding independent Claim 187, the Examiner again relies upon the same passages of Perry and Krim to reject the claim as obvious. The limitations of method Claim 175 appear in Claim 187 in apparatus form, and the key language of each limitation in both claims is the same. Therefore, because the Examiner relied upon the same passages of the same references in addressing the same operative claim language, the arguments made in Paragraph 19 above are fully applicable to each element of Claim 187. Because each and every element of Claim 187 is not disclosed or suggested by Perry in combination with Krim (which combination is impermissible as described in Paragraphs 12-16), the obviousness rejection of Claim 187 should be removed.

22. Because independent claim 187 is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03. Therefore, the obviousness rejection should be removed as to Claims 188-197.

23. The claims 175 and 187 must be considered as whole, and the prior art references must be considered as a whole. Neither Krim nor Perry disclose, or are

intended to perform, the function of the claimed invention. Krim is a "delayed communication system." Perry is a "central repository" for pre-existing documents that are scanned in. The present invention is an interactive interface for gathering information from and providing information to an input user, allowing the user to make choices via the interface regarding future care, storing these choices, and then generating an information product in response to a verified request based upon the stored choices. The present invention is neither a "delayed communication system" nor a "central repository" for pre-existing documents. Each of Krim, Perry, and the present invention is a different inventions providing different functions for a different purpose. To combine one with another would require a modification that would change the principal or operation or render the subject invention unsuitable for its intended purpose.

Summary and Conclusion

24. A prima facie case of obviousness has not been established. No objective suggestion or motivation to combine Krim and Perry was provided in the Office Action. Further, as a matter of law, Krim and Perry cannot be combined or modified to support an obviousness rejection because to do so would change the principle of operation of each reference and would render each unsuitable for its intended purpose. Even if Krim and Perry are combined as suggested by the Examiner, they do not teach each and every element of the claimed invention. In fact, as shown above, it is respectfully submitted that Krim and Perry do not teach any element of the claimed invention. Based on the foregoing, each of which provides an independent basis for withdrawal of the obviousness rejection, the Applicant respectfully submits that the obviousness rejections

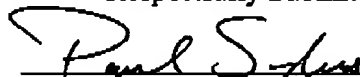
of all pending claims based on Krim and Perry is improper and requests the rejections be withdrawn.

The applicant submits that the present claims are allowable over the prior art of record. It is believed the application is therefore in condition for allowance, and such action is respectfully requested. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (205) 521-8766 so that such issues may be resolved as expeditiously as possible.

7-13-2005

Date

Respectfully Submitted,



Paul Sykes

Attorney for Applicant
Reg. No. 43,942

Of Counsel:

T. Gregory Peterson, Ph.D.
BRADLEY ARANT ROSE & WHITE LLP
One Federal Place
1819 Fifth Avenue North
Birmingham, AL 35203-2104
Telephone: (205) 521-8766